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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,445	07/23/2003	Timothy Lovenberg	JJPR-0032	1837

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EXAMINER

KOLKER, DANIEL E

ART UNIT PAPER NUMBER

1649

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,445

Applicant(s)

LOVENBERG ET AL.

Examiner

Daniel Kolker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9, 10, 13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 9, 10 and 13 is/are allowed.
- 6) ☒ Claim(s) 6 and 16 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/21/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 21 February 2006 has been entered.
2. In the previous office action, claims 1 – 3, 6 – 7, 10, 13, and 16 were amended via examiner's amendment, and claim 12 was canceled by examiner's amendment.
3. Claims 1 – 4, 6 – 7, 9 – 10, 13, and 16 are pending and under examination.

Priority

4. For the reasons set forth at page 2 of the office action mailed 26 April 2005, the priority date for all pending claims is 22 February 2001. Applicant did not traverse this statement as no intervening art was applied.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodearl (US Patent 5,882,893, issued 16 March 1999).

Claim 6 requires that the claimed vector contain a nucleic acid which encodes "an amino acid sequence of SEQ ID NO:8." The term "an amino acid sequence" reads on any size fragment of SEQ ID NO:8. While claim 6 requires that the protein be "a murine histamine H4 receptor" the claim does not require that the protein encoded by the nucleic acid in the vector have any particular function or size or sequence. Rather it is sufficient, according to the broadest reasonable interpretation of the claim, that "an amino acid sequence" be encoded by the nucleic acid.

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Goodearl teaches nucleic acid sequence SEQ ID NO:1. Many of the nucleotides of this sequence encode amino acids in applicant's SEQ ID NO:8. For example, bases 510 – 542 of Goodearl's SEQ ID NO:1 encode amino acids 55 – 65 of applicant's SEQ ID NO:8 (see enclosed alignment). Goodearl also teaches vectors comprising the nucleic acid sequence, see for example column 4 lines 41- 49 as well as column 22, line 43 – column 25 line 45. Thus the prior art reference meets all the limitations of the invention of claim 6. Goodearl also teaches introducing the vector into a cell and recombinantly expressing the protein encoded by the vector. See column 25 line 46 – column 26 line 36), and therefore anticipates claim 16.

This rejection could be overcome by amending "a nucleic acid sequence encoding a murine histamine H4 receptor protein having an amino acid sequence of SEQ ID NO:8" to read "a nucleic acid sequence encoding a murine histamine H4 receptor protein having the amino acid sequence of SEQ ID NO:8".

Conclusion

6. Claims 1 – 4, 9 – 10, and 13 are allowed for the reasons of record.

Claims 6 and 16 are rejected.

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kolker whose telephone number is (571) 272-3181. The examiner can normally be reached on Mon - Fri 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel E. Kolker, Ph.D.

June 16, 2006



ROBERT C. HAYES, PH.D.
PRIMARY EXAMINER